



Attorney's Docket No.: 06129-156001»

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TECHNOLOGY CENTER R3700  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kevin H. Gillespie  
Serial No. : 09/458,415  
Filed : December 10, 1999  
Title : SHOE OUTSOLE

Art Unit : 3728  
Examiner : Anthony D. Stashick

BOX AF  
Commissioner for Patents  
Washington, D.C. 20231

REPLY BRIEF

Pursuant to 37 CFR 1.193(b)(1), Applicant responds to the new points raised in the Examiner's Answer as follows.

At page 8, paragraph (11)(8)(A)(1) of the Examiner's Answer, the Examiner states that

[t]he preambular limitation of a baby shoe is only a statement of preferred or intended use of the sole. There is no structure or any other recitation in the body of the claim that would give life, scope or meaning to the preambular recitation of a baby shoe.

Appellants disagree. Claim 1, as well as Appellants' other independent claims, requires, in the body of the claim, that the shoe outsole be "dimensioned for use in a baby shoe", and the inner member be "positioned and dimensioned to fit under a baby's heel during use of the baby shoe." This language is not "preambular," and is clearly not a statement of intended use, but rather constitutes structural limitations concerning the shoe outsole and the inner member. The Examiner is not free to simply ignore this claim language.

This structural language is simply not met by the Tomat reference, which does not teach or remotely suggest a baby shoe, much less a baby shoe having an inner member positioned and dimensioned to fit under a baby's heel during use of the baby shoe. Thus, Appellants' arguments concerning the importance of the distinction between adult and baby shoes, and supporting

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declarations, demonstrate the patentability of Appellants' claimed shoe over the Tomat reference and must be given proper consideration.

Referring to page 9, paragraph (11)(8)(A)(2) of the Examiner's remarks, as discussed in Appellant's Appeal Brief, reading the claims in light of Appellants' specification the "intermediate region," in which the "intermediate member" is disposed lies between the "outer member" and "inner member." Interpreting Tomat in the manner proposed and diagrammed by the Examiner, the "intermediate member" (forward insert 11) is surrounded by the "outer member" and forward of and separate from the "inner member" (rear insert 11). The forward insert 11 cannot fairly be construed to lie between something that surrounds it (the "outer member") and something that is next to or behind it (the "inner member"). Thus, the Examiner's own diagram does not support the Examiner's assertion that the forward insert 11 should be construed as corresponding to Appellants' claimed intermediate member.

Moreover, with regard to claim 7, clearly Tomat's forward insert 11 does not extend to within about 2 mm of a back edge of his "outer member."

At pages 10-11, paragraph (11)(8)(D), the Examiner asserts that

[i]t appears that appellant is arguing more than that which is claimed. It appears that appellant is arguing that the upper surface of the forefoot region contains grooves, whereas the claims only require that an upper forefoot region have grooves.

Claim 49 recites "*an upper surface* including an opposite, upper forefoot region." Thus, it is unclear to Appellants why the Examiner believes that "appellant is arguing more than that which is claimed."

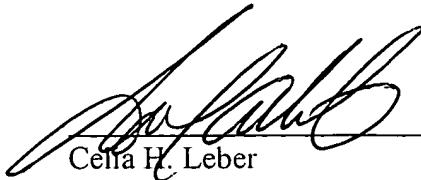
For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejection should be reversed.

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Respectfully submitted,



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